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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,696	01/19/2001	Kazuhiro Fujii	SIC -00-004	9689

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EXAMINER

BOEHLER, ANNE MARIE M

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/766,696

Applicant(s)
Fujii

Examiner
Anne Marie Boehler

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3611



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above, claim(s) 19-53, 55-65, and 74-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 54, 66-73, and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5, 6 6) ☐ Other:

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1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- 1) the embodiment of Figures 1-6;
- 2) the embodiment of Figures 7-8B;
- 3) the embodiment of Figures 9-10;
- 4) the embodiment of Figures 11-12; and
- 5) the embodiment of Figures 13-15B.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 66, 67, and 77 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with James Deland on July 25, 2002 a provisional election was made with traverse to prosecute the invention of the embodiment of Figures 1-6, claims 1-18, 54, 66-73, and 77. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-53, 55-65, and 74-76 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Claims 1-18, 54, 66-73 and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, claim 17, line 1, claim 66, line 2, claim 68, line 1, and claim 70, line 1, "of the type" is indefinite and should be deleted.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-13, 16, 54, 66, 67, 69, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Chappell (USPN 4,599,079).

Chappell shows a bracket for mounting a motor controlled derailleur shifter to the chain stay of a bicycle frame. The bracket includes a bracket base 42 having a first bracket support (which connects to the chain stay via the axle and hook 48) and a second bracket support (forward downwardly extending arm which connects to a chain stay at hook 46). Each arm is bent to be laterally offset from the center of the base. Part of the base includes a flange with a tubular extension that presents vertical and horizontal surfaces for mounting a part 103 of the control device. The second bracket support includes a mounting opening 100 through which a bolt end 93 extends.

6. Claims 1, 2, 13, 15, 66, 69, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Spicer.

Spicer shows a bracket for mounting a controller to a bicycle chain stay. The bracket includes a base 15, with a flat upper edge, and a pair of bracket supports 26 for connection to the chain stay.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappell.

Chappell shows a mounting hole 100 for accepting a bolt which then connects to a nut. It is old and well known and would have been obvious to incorporate a nut into a mounting hole (threading the hole for connection to a bolt), in order to eliminate the need for a separate bolt which can be lost.

9. Claims 17, 68, and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chappell in view of Gardel et al..

Chappell lacks a bracket support bridge adapted to bridge first and second chain stays.

Gardel shows a bicycle with a shift controller 18 having a base 26 adapted to mount to a pair of bicycle stays 30 using a support bridge 28.

It would have been obvious to one of ordinary skill in the art to provide the Chappell bracket with a bridge, as taught by Gardel, in order to prevent rotation of the bracket about the chain stay.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappell and Gardel as applied to claim 17 above, and further in view of Spicer.

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The combination fails to teach a clamping band for coupling the first support to the chain stay.

Spicer shows a shift controller with clamping bands for connecting the bracket base 15 to a chain stay.

It would have been obvious to one of ordinary skill in the art to connect the first bracket support using a clamping band, as taught by Spicer, in order to securely connect the bracket support.

11. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chappell and Gardel as applied to claim 72 above, and further in view of Suga.

The combination lacks an elongated opening in the bracket support for adjusting the position of the bridge relative to the bracket support.

In Figures 11 and 12, Suga shows a bracket base 15, with a bracket support 46 and a clamping member 38a for connection to the chain stay. The bracket support mounting wall includes an elongated slot 48 for adjusting the vertical position of the bracket support relative to the clamping member.

It would have been obvious to one of ordinary skill in the art to provide the combination bracket support with an elongated slot, as taught by Suga, in order to allow vertical adjustment of the base relative to the clamping member.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Stites, Chappell (USPN 4,693,700), Kitamura, Fey, Mimura, Wakebe, Bellio, Pikoulas, Liu, and Fujii (USPN 6,244,415) show transmission controllers mounted above chain stays of a bicycle.

Driver, and Browning show additional transmission controllers mounted to chain stays.

Davidson, Lewis, show motors mounted to brackets which bridge the two chain stays.

Glenny and Meier show brackets with elongated slots for adjusting the position of one bracket part relative to another.

Havener, Baghrzadeh, Rehn, Desmond, and Wheaton show brackets for mounting a bracket base to bicycle chain stays.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Boehler whose telephone number is (703) 308-0422.

AmBoehl 8/7/02
ANNE MARIE BOEHLER
Primary Examiner

boehler
August 7, 2002